

REMARKS

Summary of the Office Action

Claims 1-15 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 1-15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,387,478 to *Fujimoto*.

Summary of the Response to the Office Action

Applicant has amended claims 1, 10, 11, 13 and 14.

Applicant traverses the rejection of claims 1-15 under 35 U.S.C. § 103(a) as unpatentable over *Fujimoto*.

Claims 1-15 are pending.

The Rejections under 35 U.S.C. § 112, Second Paragraph

The Office Action rejects claims 1-15 under 35 U.S.C. § 112, second paragraph. Claims 1, 13 and 14 stand rejected under 35 U.S.C. § 112, second paragraph because the term viscosity “may refer to various viscosities.” (Office Action, Paragraph 2). Applicant has amended claims 1, 13, and 14 to recite a melt viscosity. Support for melt viscosity may be found in the Applicant’s Specification, for example, on page 7, lines 24-25. Accordingly, no new matter has been added.

Claim 10 stands rejected under 35 U.S.C. § 112, second paragraph because the limitation “the back surface” lacks antecedent basis. Similarly, claim 11 stands rejected under 35 U.S.C. §

112, second paragraph because the limitation “the top surface and the back surface” lacks antecedent basis. Claims 1, 10 and 11 have been amended to recite a first and/or second surface of the base material.

Claim 13 stands rejected under 35 U.S.C. § 112, second paragraph because “it is unclear whether the Applicant’s intent is to claim the image supporting member without the image formed by the color toner particles or whether the Applicant is now claiming the imaged member.” (Office Action, Paragraph 5). Applicant’s Specification discloses the “thermoplastic resin of the color toner image 4, for example, a polyester resin or a styrene-acrylic resin, a temperature t' at which the viscosity becomes 10^4 Pa·s being $t \pm 10^\circ\text{C}$, is used as a main component” as illustrated by Figure 1 and described, for example, in Applicant’s Specification on page 11, lines 21-25.

Accordingly, Applicant respectfully submits that the rejections under 35 U.S.C. § 112, second paragraph should be withdrawn.

The Rejections under 35 U.S.C. § 103(a)

Claims 1-15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,387,478 to *Fujimoto*. Applicant respectfully traverses the rejection for at least the following reasons.

Regarding independent claims 1 and 14, as amended, Applicant respectfully submits that *Fujimoto* does not teach or suggest a combination comprising a thermoplastic resin of the light scattering layer made of a polyolefin or a polyolefin copolymer, a temperature T at which the

melt viscosity becomes 5×10^3 Pa·s being 120°C or higher, and the thermoplastic resin of the color toner receiving layer is a polyolefin copolymer, a temperature t at which the melt viscosity becomes 10^3 Pa·s being from 90 to 120°C as recited. The Office Action states that “*Fujimoto* does not teach the viscosity, or more particularly, the melt viscosity.” (Office Action, Paragraph 8). Accordingly, *Fujimoto* does not teach or fairly suggest specific values of the melt viscosity as claimed. The effects of the claimed values are described in the Applicant’s Specification on page 9, lines 14-17 and page 10, lines 3-6. The Office Action attempts to resolve this deficiency in *Fujimoto* by stating “it is known in the a[r]t that the melt viscosity of the polymer of the image receiving layer affects the adherence of the toner particles, and in turn, the image quality.” (Office Action, Paragraph 8). By contrast, the present invention focuses on the melt viscosity of both the light scattering layer and color toner receiving layer.

Applicant respectfully asserts that the rejection of claims 1-15 under 35 U.S.C. § 103(a) should be withdrawn because *Fujimoto* does not teach or suggest each feature of independent claims 1 and 14. Furthermore, Applicant respectfully asserts that dependent claims 2-13 and 15 are allowable because of dependence from one of independent claims 1 or 14, and the reasons set forth above.

Conclusion

In view of the foregoing, Applicant respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the Applicant’s

undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully Submitted,

By: Mary Jane Boswell
Mary Jane Boswell
Reg. No. 33,652

Dated: 10/27/05

MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, DC 20004
Tel.: 202.739.3000
Fax: 202.739.3001